

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Andrew M. SPENCER

Confirmation No.:

Application No.: 10/002,210

Examiner: D. A. Hess

Filing Date: 12/05/2001

Group Art Unit: 2876

Title: MULTIPLE INTERFACE MEMORY CARD

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith in triplicate is the Appeal Brief in this application with respect to the Notice of Appeal filed on July 29, 2003.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$320.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(X) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

(X) one month	\$110.00	10/02/2003 AWONDAF1 00000076 082025 10002210
() two months	\$410.00	02 FC:1251 110.00 DA
() three months	\$930.00	
() four months	\$1450.00	

() The extension fee has already been filled in this application.

() (b) Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$430.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

() I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450. Date of Deposit: _____

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Respectfully submitted,

Andrew M. SPENCER

By _____

William T. Ellis

Attorney/Agent for Applicant(s)

Reg. No. 26,874

Date: 09/30/2003



Atty. Dkt. No. 10014184-1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Andrew M. SPENCER
Title: MULTIPLE INTERFACE MEMORY CARD
Appl. No.: 10/002,210
Filing Date: December 5, 2001
Examiner: D. A. Hess
Art Unit: 2876

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APPELLANT'S BRIEF UNDER 37 C.F.R. 1.192

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

The following is Appellant's Brief, submitted in triplicate and under the provisions of 37 C.F.R. 1.192. The fee of \$320.00 required by C.F.R. 1.17(c) is provided in a check submitted herewith. Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commission is hereby authorized to charge Deposit Account 19-0741 for any such fees; and appellants hereby petition for any needed extension.

1. **REAL PARTY IN INTEREST**

The real party in interest is the assignee of record, Hewlett-Packard Company.

2. **RELATED APPEALS AND INTERFERENCES**

There are no related Appeals or Interferences.

3. **STATUS OF CLAIMS**

The present appeal is directed to claims 1 and 3-9, i.e., all of the presently pending claims in this application.

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4. **STATUS OF AMENDMENTS**

The present application is under a final rejection. Appeal of the pending claims is appropriate because all of the claims have been twice rejected. See 35 U.S.C. § 134(a). There are no amendments to the claims pending subsequent to a final rejection.

5. **SUMMARY OF INVENTION**

A first aspect of the present invention is directed to a memory card (see e.g., element 10 of Figure 1), and a second aspect of the present invention is directed to a related method of operating a memory card. The memory card according to the first aspect of the invention comprises a memory mass storage 20 (see Figure 1). The memory card also comprises a first data interface 30 with contacting interfaces, and a second data interface 40 with a contact-less interface (see Figure 1), where the first data interface has a higher data transfer rate than the second data interface. Finally, the memory card comprises a memory card controller 50 for selecting a data line from the first data interface or a data line from the second data interface to communicate with the memory mass storage based on a criteria (see Figure 1). Thus, in the present invention as embodied in claim 1, the memory card includes a memory mass storage, and a memory card controller that selects a data line from either the first data interface or a data line from the second data interface to communicate with the memory mass storage.

The second aspect of the invention is directed to a method of operating a memory card. The method comprising the steps of monitoring for a predetermined signal, and switching an input to a memory mass storage from a cable data interface to a contactless data interface upon detection of the predetermined signal.

6. ISSUES

The issues on appeal are whether the Examiner erred in rejecting claims 1, and 3-9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,377,218 to Nelson et al. (hereafter "Nelson").¹

7. GROUPING OF CLAIMS

The claims do not stand or fall together. The claims are grouped as follows:

Group 1: Claims 1 and 3-5.

Group 2: Claims 6-9.

8. ARGUMENT

A. Group 1

It is respectfully submitted that the Examiner's rejection of the claims in Group 1 is erroneous for at least the following reasons:

Independent claim 1 is directed to a memory card comprising a memory mass storage. Nelson not only fails to disclose a memory card with a memory mass storage, but teaches away from including a memory mass storage on its disclosed peripheral component.

Nelson is directed to a peripheral component (see abstract) that allows a number of different types of connections to a computer or other host device. The peripheral component 108 is coupled to a host device 120, such as a computer system (Fig. 1, col. 3, lines 26-33). The peripheral component 108 may be inserted into the host device 120 and allows for various connections to be made via the peripheral component (col. 3, lines 33-37). The peripheral component 108 provides a number of possible connections for the host device

¹ Appellant notes that while the Final Office Action of March 26, 2003 also refers to U.S. Patent No. 5,619,396 to Gee et al. (hereafter "Gee") in the rejection of the claims under 35 U.S.C. § 103(a), the Examiner makes clear in the later Advisory Action of June 18, 2003 that the mention of Gee in the rejection was merely accidental. Specifically, the Examiner states in the Advisory Action: "While the examiner improperly an (sic) accidentally made mention of another reference, Gee, in the second action, this reference was not included in the rejection." Thus, for the purposes of this Appeal, Appellant addresses the rejection under 35 U.S.C. § 103(a) as intended by the Examiner, i.e., based upon Nelson.

including an Ethernet connection 125 (Figure 1, col. 3, lines 44-48), a wireline connection for connecting the host device to a peripheral device (col. 3, lines 49-53), and a wireless connection (see RF device 200) for connecting the host device (col. 3, lines 60-63). Nelson also specifically discloses that the peripheral component 108 may be a PCMCIA card (col. 3, lines 38-39).

The Examiner appears to correctly recognize that Nelson fails to disclose that the peripheral component has a memory mass storage (see Final Office Action, page 3, paragraph 4), but argues that it would have been obvious to one of ordinary skill in the art to include a memory mass storage in the Nelson peripheral component in the case that the peripheral component were a PCMCIA card. Appellant respectfully disagrees.

The purpose of the Nelson peripheral component is for providing various connections between the host device and other devices, not to provide memory for the host device. Nelson discloses that his invention of a peripheral component is for the purpose of providing various connections between the host device and other devices: “[a] peripheral component, providing multiple types of interfaces,” (abstract) and “[t]he present invention provides a peripheral component providing multiple types of interfaces.” (col. 2, lines 8-9). Since the purpose of the Nelson peripheral component is for providing connections for a host device, there is no need to provide a memory mass storage on the Nelson peripheral component, and it would not have been obvious to have modified the Nelson peripheral component to provide such an unnecessary memory.

Moreover, Nelson teaches away from including memory mass storage on its peripheral component, because Nelson discloses that there is limited space on such peripheral components, and thus one skilled in the art would not have used the limited space to include a function (memory mass storage) which would not be required by the peripheral component. Nelson discloses that peripheral components, such as PCMCIA cards have very limited space (col. 1, lines 42-44), and that prior techniques evidenced problems with interfering with circuitry inside a peripheral component where the components have very limited internal space (col. 1, lines 58-60). Nelson clearly sees this space limitation as important, and

discloses embodiments which interfere minimally with the logical circuitry inside the peripheral component (col. 2, lines 13-15). As discussed above, the purpose of the Nelson peripheral device is for providing various connections between the host device and other devices, not to provide memory for the host device. Given the space limitations on the Nelson peripheral component as disclosed by Nelson, one skilled in the art would not have added unnecessary functionality, such as memory, to the Nelson peripheral component.

Claim 1 also includes a memory card controller, a feature not found in the Group 2 claims. The claims in Group 1 are separately patentable from the Group 2 claims for at least the reason that the Group 1 claims include the memory card controller for selecting a data line from the first data interface or a data line from the second data interface to communicate with the memory mass storage.

Moreover, Nelson failing to disclose or suggest a memory mass storage, necessarily fails to disclose a memory card controller for selecting a data line from the first data interface or a data line from the second data interface to communicate with the memory mass storage, as recited in claim 1.

Accordingly, this rejection cannot stand. Therefore, for at least the reasons stated above, the claims of Group 1 are patentable over Nelson.

B. Group 2

It is respectfully submitted that the Examiner's rejection of the claims in Group 2 is erroneous for at least the following reasons:

Independent claim 6 is directed to a method of operating a memory card, comprising the steps of monitoring for a predetermined signal, and switching an input to a memory mass storage from a cable data interface to a contactless data interface upon detection of the predetermined signal. As discussed above with respect to claim 1, Nelson not only fails to disclose a memory mass storage in his peripheral component, but teaches away from

including a memory mass storage in light of the peripheral component's space constraints. Thus, claim 6 is likewise patentable over Nelson.

Accordingly, this rejection cannot stand. Therefore, for at least the reasons stated above, the claims of Group 2 are patentable over Nelson.

9. **SUMMARY**

For at least the foregoing reasons, it is submitted that the Examiner's rejections are erroneous, and reversal of the applied rejections is respectfully requested.

Respectfully submitted,

Date September 30, 2003

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APPENDIX

Presently Pending Claims

1. (Previously Presented) A memory card, comprising:
a memory mass storage;
a first data interface with a contacting interface;
a second data interface with a contact-less interface, the first data interface having a higher data transfer rate than the second data interface; and
a memory card controller for selecting a data line from said first data interface or a data line from said second data interface to communicate with said memory mass storage based on a criteria.
2. (Cancelled)
3. (Previously Presented) The memory card as defined in claim 1, wherein said criteria is a predetermined card select detect signal from said first interface.
4. (Previously Presented) The memory card as defined in claim 1, wherein said criteria is a detecting an indication of a carrier detect signal from said second data interface.
5. (Original) The memory card as defined in claim 1, wherein the first interface is a contacting interface for one of the following applications: a secure digital application, multimedia card, compact flash, memory stick, or a PCMCIA.
6. (Original) A method of operating a memory card comprising the steps of:
monitoring for a predetermined signal, and
switching, an input to a memory mass storage from a cable data interface to a contactless data interface upon detection of the predetermined signal.
7. (Original) The method as defined in claim 6, wherein said monitoring step comprises detecting a carrier signal.
8. (Original) The method as defined in claim 6, wherein said monitoring step comprises detecting a predetermined command signal.
9. (Original) The method as defined in claim 6, wherein the monitoring and switching steps are performed automatically at power-up.